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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/071,707	02/08/2002	Yongping Yu	IMS-45.0 (6078/84549)	4006

24628 7590 08/12/2003

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EXAMINER

EPPERSON, JON D

ART UNIT	PAPER NUMBER
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1639

DATE MAILED: 08/12/2003

7

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/071,707

Applicant(s)

YU ET AL.

Examiner

Jon D Epperson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 14 May 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) 1-10 and 21-27 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 11-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 5.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

## DETAILED ACTION

### *Status of the Application*

1. Receipt is acknowledged of a Response to a Restriction Requirement, which was dated on May 14, 2003 (Paper No. 6).

### *Priority Claims*

2. No foreign or domestic priority is claimed. Therefore, the effective filing date of the claims is the filing date of the case i.e., February 8, 2002.

### *Status of the Claims*

3. Claims 1-27 are pending in the present application.
4. Applicant's response to the Restriction and/or Election of Species requirements in Paper No. 6 is acknowledged (Applicant elected Group II, claims 11-20) and claims 1-10 and 21-27 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to nonelected inventions, there being no allowable generic or linking claim (see below i.e., Response to Restriction and/or Election of Species).
5. Please note: Applicant's *specifically* elected species (compound 10a in Table 1 at page 40) was searched and was not found in the prior art. Thus, the search was expanded to non-

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elected species, which *were* found in the prior art, see rejections below. Also, see MPEP §

803.02 (emphasis added):

On the other hand, should no prior art be found that anticipates or renders obvious the elected species, the search of the Markush-type claim will be extended. If prior art is then found that anticipates or renders obvious the Markush-type claim with respect to a nonelected species, the Markush-type claim shall be rejected and claims to the nonelected species held withdrawn from further consideration. *The prior art search, however, will not be extended unnecessarily to cover all nonelected species.* Should applicant, in response to this rejection of the Markush-type claim, overcome the rejection, as by amending the Markush-type claim to exclude the species anticipated or rendered obvious by the prior art, the amended Markush-type claim will be reexamined. The prior art search will be extended to the extent necessary to determine patentability of the Markush-type claim. In the event prior art is found during the reexamination that anticipates or renders obvious the amended Markush-type claim, the claim will be rejected and the action made final. Amendments submitted after the final rejection further restricting the scope of the claim may be denied entry.

6. Therefore, claims 11-20 are examined on the merits in this action.

#### *Response to Restriction and/or Election of Species*

7. Applicant's election of Group II (claims 11-20) in Paper No. 6 is acknowledged.

Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

8. Applicant's election of species in Paper No. 6 is also acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election of species has also been treated as an election without traverse (MPEP § 818.03(a) and/or 37 CFR 1.111(b)).

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9. As a result, the restriction requirement and/or election of species is still deemed proper and is therefore made FINAL.

***Information Disclosure Statement***

10. The listing of references in the specification is not a proper information disclosure statement. 37 CFR 1.98 (b) requires a list of all patents, publications, or other information submitted for consideration by the Office, and MPEP § 609 A(1) states, "the list may not be incorporated into the specification but must be submitted in a separate paper." Therefore, unless the references have been cited by the examiner on the form PTO-892, they have not been considered.

11. The references listed on applicant's PTO-1449 form have been considered by the Examiner. A copy of the form is attached to this Office Action.

***Specification***

12. The specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

***Claims Rejections - 35 U.S.C. 102***

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The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

13. Claims 11-20 are rejected under 35 U.S.C. 102(b) as being anticipated by Herweh et al (U.S. Patent No. 4,053,538) (Date of Patent is **October 11, 1977**).

For *claims 11-12*, Herweh et al (see entire document) discloses 1, 3, 5-Triazine-1,3 (2H,4H)-diacetic acid (referred to as "phenyl diacetic compound" herein) (see Herweh et al, see column 3, lines 60-67; see also column 4, paragraph 1; see also attached CAPLUS reference number 53192-64-6P), which anticipates claim 1. Here, the disclosed 1,3,5-trisubstituted 1,3,5-triazine-2,4,6-trione contains [a]  $R^1 = H$  (i.e., a hydrido), [b]  $R^2 = CH_2CO_2H$  (i.e., a "C<sub>1</sub>-C<sub>10</sub> substituted alkyl"), [c]  $R^3 = \text{phenyl}$  and [d]  $X = O$ .

For *claim 13*, Herweh et al discloses that  $R_2$  can be a methyl (see column 3, line 66; see also attached CAPLUS reference number 53192-77-1). In this scenario the R group shown in the formula in column 3 lines 60-65 represents the  $R_2$  group wherein the acetic acid groups represent the  $R_3$  and  $R_1$  compounds.

For *claim 14*, Herweh et al discloses that  $R_3$  can be a hydrogen (see Herweh et al, column 3, line 67).

For *claims 15-20*, Herweh et al discloses a "Gly" side chain (see Herweh et al, CAPLUS reference number 53192-64-6P mentioned above wherein  $R_1 = H$ , which is the

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side chain of Gly). Again, as mentioned above the R2 or R3 groups could be a hydrido, phenyl, methyl, etc (see attached CAPLUS reference number 53192-64-6p, 53192-77-1).

***Contact Information***

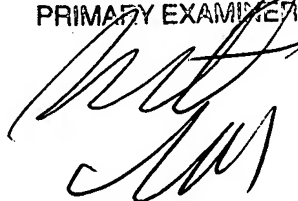
14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jon D Epperson whose telephone number is (703) 308-2423. The examiner can normally be reached Monday-Friday from 9:00 to 5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Wang can be reached on (703) 306-3217. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9306 for regular communications and (703) 872-9307 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-2439.

Jon D. Epperson, Ph.D.  
August 9, 2003

BENNETT CELSA  
PRIMARY EXAMINER

A handwritten signature in black ink, appearing to read 'Bennett Celsa', is written over the printed name and title.